

U.S. Pat. App. No. 09/490,553

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
MORGAN

Serial No. 09/490,553

Filed: January 25, 2000

For: A System for Providing Internet-
Related Services to Handheld Devices

Group Art Unit: 2154

Examiner: Lin, Kenny

Attorney Docket No. PDNO 10992213-1

Date: October 24, 2003

RESPONSE

Commissioner for Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

Sir:

I. The Foreign References

Applicants' attorney thanks the Examiner for his telephone call of October 23, 2003, pursuant to which the Examiner mentioned that the Examiner was considering citing foreign patent references Japanese Application Nos. 10172133 and 10173844 (collectively, the "Japanese References"), published respectively on December 21, 1999 and December 24, 1999 (collectively, the "Japanese Publication Dates"), against the pending application.

II. The DASWANI Reference

In an office action mailed June 16, 2003, the Examiner also previously rejected Claims 1-2, 4-5, 7, 10-11, 13, 15-16, 20, 22-24, 29 and 32-34 under 35 U.S.C. §102(e) as being anticipated by Daswani et al., U.S. Patent No. 6,477,565 ("DASWANI") which per the Examiner has a 35 U.S.C. 102(e) date of September 1, 1999 (the "DASWANI 102(e) Date")

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III. Swearing Behind the Foreign References and DASWANI

As agreed between the Examiner and Applicant's attorney by telephone on October 24, 2003, Applicants hereby swear behind the Japanese references and DASWANI pursuant to 37 CFR 1.131. The attached declarations show that Applicants conceived and reduced to practice the inventions of every independent claim of the pending application prior to the Japanese Publication Dates and the DASWANI 102(e) Date. Therefore, the foreign references and DASWANI are not eligible as prior art to the pending application. Accordingly, Applicants respectfully request that the application be passed to allowance.

IV. Withdrawal of Prior Amendments in Response of October 16, 2003

As further agreed between the Examiner and Applicants' attorney by telephone on October 24, 2003, the Applicants hereby withdraw all amendments made in a response to office action filed by facsimile on October 16, 2003. Applicants attorney thanks the Examiner for, and accepts, the Examiner's offer to not enter the October 16 response.¹ Because of the non-entry of the October 16, 2003 response there is no need for, and Applicants do not now submit, any additional amendments reinstating the claims to their status prior to October 16, 2003.

V. Withdrawal of Prior Amendments in Response of August 13, 2003

Applicants' swearing behind of DASWANI also eliminates the need for arguments distinguishing DASWANI made in a response to office action filed on August 13, 2003. Accordingly, Applicants now formally withdraw all such arguments (but not the amendments) made in the August 13, 2003 response.²

VI. Conclusion

¹ Accordingly, the now-withdrawn amendments should not be used for claims construction or prosecution history estoppel reasons.

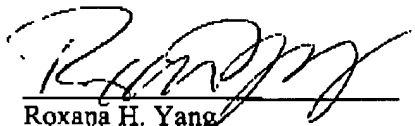
² Accordingly, the now-withdrawn arguments should not be used for claims construction or prosecution history estoppel reasons.

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In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. Should the Examiner believe that a telephone interview would help advance the prosecution of this case, the Examiner is requested to contact the undersigned attorney.

Respectfully submitted,

By:


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